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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,704	07/29/2005	Jan De Kroon	4662-302	2461
23117 7590 01/09/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
FREEMAN, JOHN D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
01/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/520,704

Applicant(s)

DE KROON ET AL.

Examiner

John Freeman

Art Unit

1794

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 22 December 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4 and 6-9.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Callie E. Shoshol/
Supervisory Patent Examiner, Art Unit 1794

/J. F./
Examiner, Art Unit 1794

Continuation of 11.

The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

Regarding Amendments:

Applicant's amendment overcomes the previous objection. The examiner acknowledges claim 5 was cancelled in the previous set of claims. The examiner erroneously left the claim in the rejection, and on the Office Action Summary. As this does not affect other claims, those rejections stand. The proper status of the claims has been indicated on PTO-303.

Regarding the Double Patenting Rejection: Applicant states the examiner takes the position that "the improvement sought to be patented herein is merely a matter of obvious choice or design as compared to the invention claimed in the '595 application" (p5). In fact the examiner takes the position that the identified claims of each application describe multilayer structures that are substantially the same, and therefore are not patentably distinct, as noted in the Office Action mailed 22 July 2008. Applicant argues "in situations such as this, the issue is not one of 'obviousness', but rather one of 'identity of invention'" (p6). As noted in the basis for the nonstatutory double patenting rejection:

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Applicant further argues "one of the claims of one of the '595 application and the present application could be infringed literally without infringing literally the claims of the other" (p6). The examiner respectfully disagrees: the present claim 1 recites a process comprising the "application of a layer of a [branched] polyamide to a substrate", and claim 1 of '595 recites a process comprising "connecting [a branched] polyamide layer to [a] layer of another polymer". Clearly a layer of another polymer is necessarily a substrate. Therefore, an infringement upon claim 1 of '595 would necessarily infringe upon claim 1 of the present application.

Regardless, the terminal disclaimer filed on 22 December 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/517,595 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, the double patenting rejection is withdrawn.

Regarding Rejections under 35 USC 103(a):

Applicant argues "Nijenhuis does not relate to a laminate structure nor to a process of making a laminate, let alone that branched polyamides allow for thickness stability...to be achieved for such a laminate" (p6). The examiner notes no limitations regarding "thickness stability" are found in the present claims. Furthermore, if Applicant submits that the use of the present branched polyamide provides the "thickness stability", then the use of the polyamide in a laminate inherently provides such thickness stability.

Applicant argues Cahill "is completely silent about thickness distribution when employing polyamides to a laminate, let alone that choosing certain polyamide leads to a more even thickness distribution" (p6). Therefore, Applicant argues further, there would be no reasonable expectation for success "in view of Cahill to employ polyamides according to Nijenhuis [nor] would it be obvious to try, as nowhere in Cahill a hint is given about thickness distribution" (p6-7). Applicant further argues it would not be obvious "to try to employ these polyamides onto laminates, as nowhere in Nijenhuis laminates are mentioned, let alone that this would lead to more even thickness distribution" (p7). In response, the examiner reproduces part of paragraph 10 of the Office Action mailed 22 July 2008:

The examiner's argument does not rely on the ability of one of ordinary skill in the art to recognize the ability of Nijenhuis's branched polyamide to create a uniform thickness. Instead the examiner maintains that one of ordinary skill would recognize branched polyamides have been used in packaging applications in the past. Nijenhuis's branched polyamide is suitable for films, and therefore would reasonably expect Nijenhuis's branched polyamide would be suitable in a packaging laminate. The rejection stands. It is noted that "obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation", In re Dillon, 16 USPQ2d 1897 (Fed. Cir. 1990). In re Tomlinson, 150 USPQ 623 (CCPA 1966).

Applicant provides experimental data regarding the thickness stability of the present invention. However, it is noted that "the arguments of counsel cannot take the place of evidence in the record", In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding the thickness stability of the branched polyamide must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

The data are not persuasive because they are (1) not commensurate in scope with the claims, and (2) relate to only the difference in thickness stability between branched polyamides and non-branched polyamides for the reasons noted below:

(1) The data are not commensurate in scope with the claims the data test only one specific branched polyamide. The scope of claim 1, however, covers all polyamides conforming to the disclosed formulas. A single data point falling within the formulas does not seem to be representative of all such polyamides. Also it is unclear whether the relative loading of the various components of the branched

polyamide plays a role in the thickness stability. Finally, the inventive polyamide includes a "nucleating agent anti lubricant" and has a higher relative viscosity than the non-branched polyamide (2.95 compared to 2.65). It is unclear what effects these differences may have on the thickness stability of the polyamide.

Also, the "web stability" measurements are taken at a specific production rate of 200 m/min. The examiner posits that slower production rates may render the difference in web stability negligible. Therefore, blanket statements regarding stability may not be appropriate.

(2) The data relate to only the difference in thickness stability between branched polyamides and non-branched polyamides. The rejection over Nijenhuis in view of Cahill, however, does not result in non-branched polyamides. In fact, Nijenhuis uses the same polyamides as presently claimed. Therefore, the data do not differentiate the present invention from the prior art.

Miscellaneous:

Line 18 of the claim reads "X-B", which appears to be a typographical error. Clarification is requested for any future set of claims..